

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB JAN. 5, 00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Beth Stone DBA Pangaea International Consulting

Serial No. 75/148,916

Patricia A. Wilczynski of Scully Scott Murphy & Presser for
Beth Stone DBA Pangaea International Consulting.

Gerald C. Seegars, Trademark Examining Attorney, Law Office
106 (Mary Sparrow, Managing Attorney).

Before Quinn, Chapman and Bucher, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Beth Stone, a citizen of the United States doing
business as Pangaea International Consulting, filed an
application for registration of the mark "PANGAEA" for
"marketing and management consulting services which are
totally unrelated to banking, finance and investments,
namely, conducting marketing research and feasibility
analysis, identifying global marketing opportunities,
providing cultural analyses, and other marketing-related

services in connection with the structuring and implementation of global marketing strategies."¹

The Trademark Examining Attorney issued a final refusal to register based upon Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, "PANGAEA" when used in conjunction with these marketing and management consulting services, so resembles the registered marks, "PANGAEA" and "PANGAEA PARTNERS, LTD.," that are each registered for "investment and financial services; namely, investment and financial research, analysis, counseling and portfolio management; financial counseling and consulting on mergers, acquisitions, leveraged buyouts, tender offers, start-ups, divestitures, joint-ventures, marketing or distribution arrangements, private placements (of debt and/or equity securities), project financings, restructurings, capital markets activities and international development; merchant and investment banking; providing loans and loan services to corporations and governments; trading of financial securities for others; [and] arranging

¹ Serial No. 75/148,916, in International Class 35, filed August 12, 1996, alleging dates of first use of April 1, 1993. At applicant's request, the application was divided, with the "telecommunications services, namely, providing electronic-mail services" portion of this application proceeding to issue on December 1, 1998 as Reg. No. 2,207,357.

financing from investors and lenders for clients,"² as to be likely to cause confusion, or to cause mistake, or to deceive.

Applicant has appealed the final refusal to register. Briefs have been filed, but applicant did not request an oral hearing. We reverse the refusal to register.

In the course of rendering this decision, we have followed the guidance of In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 1362, 177 USPQ 563, 567-68 (CCPA 1973), that sets forth the factors which should be considered, if relevant, in determining likelihood of confusion.

Under the first du Pont factor, we examine the similarities or differences in sound, appearance, meaning and overall commercial impression of the two marks. As the Trademark Examining Attorney points out, applicant's mark ("PANGAEA") is identical to one of registrant's cited marks ("PANGAEA") and nearly identical to the second ("PANGAEA PARTNERS, LTD."). On this point alone, applicant seems to have conceded as much. Hence, this du Pont factor supports the refusal made by the Trademark Examining Attorney.

² Reg. No. 1,865,956, for "PANGAEA," issued on December 6, 1994. The registration sets forth dates of first use of October 17, 1989. Reg. No. 1,834,031, for "PANGAEA PARTNERS, LTD.," issued on May 3, 1994. This registration also sets forth dates of first use of October 17, 1989. Both registrations are owned by the same entity, Pangaea Partners, Ltd.

Applicant does focus on the number of "Pangaea" marks allegedly in use in the United States. Based upon the results of various automated trademark and trade name search reports, applicant argues that the term "Pangaea" is a weak mark.³ However, such search reports are of little probative value in connection with a question of likelihood of confusion in the absence of evidence of actual use of those marks. Their appearance in these search results does not prove that they are in use. Unless applicant establishes that the third-party marks shown in these computerized search results are being used, there is no way an assessment can be made as to what, if any, impact those marks may have made in the marketplace. See Seabrook Foods, Inc. v. Bar-Well Foods, Limited, 568 F.2d 1342, 196 USPQ 289 (CCPA

³ These alleged, third-party registrations were not properly made of record. In order to make third-party registrations of record, soft copies of the registrations or photocopies of the appropriate U.S. Patent and Trademark Office electronic printouts should be submitted. See Weyerhaeuser Co. v. Katz, 24 USPQ2d 1230 (TTAB 1992). This was not done. Furthermore, the printouts of the search results were merely an exhibit attached to applicant's appeal brief. Copies of the registrations are to be made part of the record prior to the time of the appeal. See, 37 CFR 2.142(d); In re Smith and Mehaffey, 31 USPQ2d 1531, 1532 (TTAB 1994). Nonetheless, in his appeal brief, the Trademark Examining Attorney treated these registrations as if of record. In his appeal brief, he commented on the substance of this evidence without objection. Although applicant did not comply with the established rules as to the form and timing for the submission of the evidentiary record in an application, the Trademark Examining Attorney appears to have waived his right to object thereto. Accordingly, we have considered this evidence in reaching our decision.

1977). Furthermore, as the Trademark Examining Attorney points out, none of these third-party registrations recites services similar in any way to the services at issue herein. Thus, even if there were proof of use of the third-party marks highlighted by applicant, any actual uses on dissimilar goods or services in unrelated fields would be irrelevant. See Sheller-Globe Corporation v. Scott Paper Company, 204 USPQ 329 (TTAB 1979) and Charrette Corp. v. Bowater Communication Papers Inc., 13 USPQ2d 2040 (TTAB 1989).

As to the origins of this word, the application and the cited registrations note that "Pangaea" comprises two separate Greek terms, "Pan" meaning "all," and "Gaea" meaning "earth." Applicant volunteered that this "refers to the original supercontinent which existed on earth before the continental drift broke up the land mass into Asia, Europe, Africa, etc." One could conclude that this term is somewhat suggestive for companies that want to stress their involvement in the global marketplace.⁴ Accordingly, while applicant argues that this mark is relatively weak, we conclude that the record does not demonstrate that "Pangaea" is a weak mark as applied to the services of either

⁴ Applicant's logo, as shown on its web pages of record, also has the tagline, "...we're putting the continents back together.™"

applicant or registrant, and this du Pont factor is largely neutral.

Given the fact that these respective marks are substantially identical, the question of likelihood of confusion turns principally on the relationship between the services herein. We need to ask whether the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise to the mistaken belief that they are in some way associated with the same provider. See, e.g., Monsanto Co. v. Enviro-Chem Corp., 199 USPQ 590, 595-96 (TTAB 1978); and In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978).

We note from registrant's recitation of services that it is an international investment banker that specializes in providing investment and financial services. In addition to providing consultation, registrant manages large international projects, operates securities brokerage firms in national markets, etc. By contrast, applicant's recitation of services is explicit in pointing out that her expertise is not in banking, finance or investments, but rather lies in providing marketing and management consulting services to her members. Her emphasis is also on the electronic tools made available on the Internet.

In reviewing closely the context for these two types of services as recited above and examining the balance of the record,⁵ we see that both registrant and applicant do share a strong focus on emerging markets in the developing nations of the world.

On the other hand, there is nothing in the record showing that international investment bankers also provide the kind of marketing consultancy services being offered by applicant. As applicant noted, the Trademark Examining Attorney seems to have latched onto two words ("consulting"

⁵ From applicant's web pages (specimens of record), we see that "PANGAEA, International Consultants is a global marketing consulting firm working with multinational or soon-to-be multinational companies exploring business opportunities abroad. We analyze country and industry trends to aid our clients with global launch programs, market entry strategies and feasibility analysis. Our country/industry overviews, consumer insight analyses, evaluation of consumer receptivity and market trends, as well as pricing and promotion opportunities in key markets enables our clients to make confident global business decisions with foresight and knowledge. Through our analytical and progressive techniques, we help our clients with global business, marketing and advertising strategy development and local tactical implementation to compete effectively in the global and local marketplace.

"We have built a strong network comprised of independent consultants and long-established companies in more than 50 markets around the world who bring local market insights and business acumen to each consulting engagement.

"In summary, PANGAEA provides clients with the tools and guidance to open new markets through thoughtful planning to execute global strategy development and local tactical implementation."

Applicant has also included information from registrant's web page confirming that

"Pangaea Partners provides expert investment banking and financial consulting services in emerging markets..."

and "marketing") found in the respective recitations of services. In the absence of a lack of proof of the relatedness of these specifically different types of services, this simply is too tenuous a connection on which to base a finding of likelihood of confusion. Hence, on the instant record, this du Pont factor supports the position of applicant that there is no likelihood of confusion.

Furthermore, we agree with applicant that both applicant and registrant would be targeting their respective services to fairly sophisticated customers. Hence, this du Pont factor also supports the position of applicant that there is no likelihood of confusion.

In conclusion, given our perceptions of the differences between registrant's and applicant's services and their respective customers' needs, we find that this record does not demonstrate that the sophisticated customers involved herein would assume international investment bankers are involved in marketing and management consulting services. We find this outweighs the fact that we are faced with substantially identical marks in a larger context where applicant and registrant have a similar emphasis on developing global markets.

Decision: The refusal to register is reversed.

T. J. Quinn

B. A. Chapman

D. E. Bucher

Administrative Trademark
Judges, Trademark Trial and
Appeal Board